

Free Trade Agreements and IT based business

Research Appendix

**AHRC Research Centre for Studies in
Intellectual Property and Technology
Law, University of Edinburgh**

Abbe Brown
Andres Guadamuz
Jordan Hatcher
Chloe Bermudez

Contents

1.0 INTRODUCTION	3
1.1 OVERVIEW	3
1.2 ELECTRONIC SEARCHES	3
1.3 USEFUL DATABASES	3
2.0 ONLINE RESOURCES	3
2.1 USEFUL WEBSITES	3
2.1.1 <i>World Trade Law</i>	4
2.1.2 <i>Domestic Legal Systems</i>	4
2.1.3 <i>Development Related Information</i>	4
2.2 BLOGS	4
2.2.1 <i>International Trade Law blogs</i>	4
3.0 ORGANISATIONS	5
4.0 SELECTED JOURNALS	5
5.0 NEWS AND OTHER PERIODICALS	5
6.0 SELECTED RESOURCES BY AREA	5
6.1 FREE TRADE AGREEMENTS AND DR-CAFTA	6
6.1.1 <i>Relevant International Documents</i>	6
6.1.2 <i>General Information</i>	6
6.1.3 <i>US Trade Act 1974, s. 301</i>	8
6.1.4 <i>Trade Promotion Authority (TPA)</i>	8
6.1.5 <i>FTAA</i>	8
6.1.6 <i>ALBA</i>	9
6.2 E-COMMERCE ISSUES	9
6.2.1 <i>General</i>	9
6.2.2 <i>Trade Law</i>	10
6.2.3 <i>E-Commerce in Latin America</i>	10
6.3 INTERMEDIARY LIABILITY	10
6.4 INTELLECTUAL PROPERTY	11
6.4.1 <i>International Aspects of Intellectual Property Law</i>	11
6.4.2 <i>Digital Rights Management</i>	11
6.4.3 <i>Anti-Circumvention measures & FTAs</i>	11
6.4.4 <i>Statutory Damages for Copyright infringement</i>	12
6.5 UDRP, WHOIS & INTERNET GOVERNANCE	12
6.5.1 <i>UDRP</i>	12
6.5.2 <i>WHOIS</i>	13
6.5.3 <i>UDRP & Internet Governance</i>	14
6.6 COMPETITION LAW	14
6.7.1 <i>Central American Competition Laws</i>	14
6.7 TELECOMS	14
6.7.1 <i>General</i>	14
6.7.2 <i>Digital Divide</i>	15
6.8 CULTURAL ASPECTS OF FTAs	15
ANNEX A: INFORMATION TECHNOLOGY AGREEMENT & FREE TRADE AGREEMENTS	16
ANNEX B: DR-CAFTA & ICANN'S UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY	22

1.0 Introduction

1.1 Overview

This research guide offers information on resources and tips for researching the free trade issues of importance to IT based businesses in general, and the Dominican Republic – Central American Free Trade Agreement (DR-CAFTA) in particular. Free trade issues can be rather divisive, and this guide aims to take a neutral approach as to materials. As such, this document gives resources from a wide variety of viewpoints. As UK researchers, the guide leans towards providing English language materials, but several of the resources presented offer material in both English and Spanish. Because the DR-CAFTA agreement and other similar agreements originate with the United States, the materials that we have uncovered tend to come from that country.

We have tried to include as many freely available resources as possible, though we do not limit ourselves to these materials.

1.2 Electronic searches

Boolean searches can be particularly useful. Below are some of the search terms that we found particularly useful. Terms from the first column were combined with terms from the second column using various connectors, such as /p and /s.

“regional trade” or “free trade” CAFTA “trade agreement!” RTA FTA	“electronic commerce” or “e-commerce” or “digital commerce” “isp liability” or “intermediary liability” DMCA (UDRP or “domain name”) ICANN WHOIS privacy
---	--

1.3 Useful databases

We searched a wide variety of databases in Westlaw, including UK-JLR, JLR, and TP-ALL.

2.0 Online Resources

2.1 Useful Websites

Law and Technology Resources for Professionals (LLRX): <<http://www.llrx.com/>>
Latin American Network Information Centre (LANIC): <<http://lanic.utexas.edu/>>
Internet Resources for Latin America: <<http://lib.nmsu.edu/subject/bord/laguia/>>

OAS Foreign Trade Information System (SICE): <<http://www.sice.oas.org/>>
Quaker United Nations Office - Online IP resources:
<<http://www.quno.org/economicissues/intellectual-property/intellectualLinks.htm#QUNOPUB>>
Latin Business Chronicle (via subscription):
<<http://www.latinbusinesschronicle.com>>

SICE has an excellent collection of materials on DR CAFTA available at:
http://www.sice.oas.org/TPD/USA_CAFTA/USA_CAFTA_e.ASP

2.1.2 World Trade Law

NYU School of Law WTO and GATT Research:
<<http://www.law.nyu.edu/library/wtoguide.html>>
World Trade Institute: <<http://www.worldtradelaw.net/>>
WTO “Regional Trade Agreements Gateway”:
http://www.wto.org/english/tratop_e/region_e/region_e.htm

2.1.3 Domestic Legal Systems

NYU Hauser Global Faculty’s GlobalLex:
<<http://www.nyulawglobal.org/globalex/index.html#>>
CIA World Factbook: <<https://www.cia.gov/library/publications/the-world-factbook/index.html>>

2.1.4 Development Related Information

Institute of Development Studies Gateway to Development Information (eldis):
<<http://www.eldis.org/index.htm>>
International Development Law Organization: <<http://www.idlo.int/>>

2.2 Blogs

Blogs can be a good way of getting information about current events and commentary on developments in the system. The following blogs may be a starting place:

Economist.com, Free Exchange: <<http://www.economist.com/debate/freeexchange/>>
Opinio Juris: <<http://www.opiniojuris.org/>>
Global Voices Online (meta blog covering a variety of issues):
<<http://www.globalvoicesonline.org/>>
Asociación Jóvenes para el Desarrollo: <<http://asojod.blogspot.com/>>

2.2.1 International Trade Law blogs

Ben Muse: <http://benmuse.typepad.com/ben_muse/>
Daniel W Drezner: <<http://www.danieldrezner.com/blog/>>
Brad DeLong: <<http://delong.typepad.com/>>
International Economic Law and Policy Blog: <<http://worldtradelaw.typepad.com/>>
Cato at Liberty: <<http://www.cato-at-liberty.org/>>

3.0 Organisations

International Centre for Trade and Sustainable Development: <<http://www.ictsd.org/>>
Electronic Frontier Foundation: <<http://eff.org>>
IP Justice: <<http://www.ipjustice.org/>>
Electronic Privacy Information Centre: <<http://www.epic.org/>>
Centre for Democracy and Technology: <<http://www.cdt.org/>>
CPTech: <<http://www.cptech.org/>>
Office of the United States Trade Representative: <<http://www.ustr.gov/>>
Public Citizen, Global Trade Watch: <<http://www.citizen.org/trade/>>
IATP Trade Observatory: <<http://www.tradeobservatory.org/index.cfm>>
Truth about Trade & Technology: <<http://www.truthabouttrade.org/>>
Focus on the Global South: <<http://www.focusweb.org/>>

4.0 Selected Journals

I-WAYS: Digest of Electronic Commerce Policy and Regulation
Law and Business Review of the Americas
University of Miami Inter-American Law Review
International Trade Journal

5.0 News and other periodicals

Many of the organisations listed elsewhere in this guide provide updates by email or have various RSS feeds available to keep subscribers current. What follows is a selection of distinctly news-oriented services and tools.

Google News: <<http://news.google.com/>>
Google Alerts: <<http://www.google.com/alerts>> Terms such as 'CAFTA' have produced good results.
Latin American News – Yahoo! News: <<http://news.yahoo.com/i/734>>
BBC Mundo.com: <<http://news.bbc.co.uk/hi/spanish/news/>>
BBC News Americas: <<http://news.bbc.co.uk/2/hi/americas/default.stm>>
Latin America – IPS Inter Press Service: <<http://ipsnews.net/latin.asp>>
Bilaterals.org: <<http://bilaterals.org>>
Newspapers in Latin America: <<http://lanic.utexas.edu/la/region/news/>>
Prensa Latina (focus on Cuba): <<http://www.plenglish.com/>>
Miami Herald – Americas: <<http://www.miamiherald.com/579/index.html>>
CNN.com World/Americas: <<http://www.cnn.com/WORLD/americas/archive/>>
Wall Street Journal: <<http://online.wsj.com/public/us>>
The Economist: <<http://www.economist.com/>>
Latinnews.com (via subscription): <<http://www.latinnews.com/>>
Business News Americas (via subscription): <<http://www.bnamericas.com/>>
IP Watch: <<http://www.ip-watch.org>>
Marcasur: <<http://www.marcasur.com/en/index.asp>>

6.0 Selected resources by area

6.1 Free Trade Agreements and DR-CAFTA

There are a wide variety of resources available on international trade law issues in general and free trade agreements in particular. The WTO website has a wealth of materials about the system, including detailed texts on the mechanics and rules of the WTO system. In addition, the Office of the United States Trade Representative website has copies of the many FTAs involving the United States, as well as secondary material on these treaties. The Bartels and Ortino work is highly recommended, as it pulls together a wide variety of perspectives on the topic of regional trade agreements.

6.1.1 Relevant International Documents

Central America-Dominican Republic-United States Free Trade Agreement (August 5, 2004):

<http://www.ustr.gov/Trade_Agreements/Bilateral/CAFTA/CAFTADR_Final_Texts/Section_Index.html>

WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)(April 15, 1994): <http://www.wto.org/english/docs_e/legal_e/27-trips_05_e.htm>

North American free Trade Agreement (Came into effect: January 1, 1994):

<http://www.nafta-sec-alena.org/DefaultSite/index_e.aspx?DetailID=78>

General Treaty on Central American Economic Integration between Guatemala, El Salvador, Honduras and Nicaragua signed at Managua (December 13, 1960):

<http://www.worldtradelaw.net/fta/agreements/cacmfta.pdf>

Australia-US Free Trade Agreement (January 1, 2005):

<http://www.dfat.gov.au/trade/negotiations/us_fta/final-text/index.html>

Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001, on the harmonization of certain aspects of copyright and related rights in the information society: <http://eur-lex.europa.eu/LexUriServ/site/en/oj/2001/l_167/l_16720010622en00100019.pdf>

6.1.2 General Information

6.1.2.1 International Trade

Bartels, L. & Ortino, F., *Regional Trade Agreements and the WTO Legal System* (2006).

Bhagwati, J., "U.S. Trade Policy: The Infatuation with Free Trade Agreements", in: Krueger, J. & Krueger, A.O., *The Dangerous Drift to Preferential Trade Agreements*, (1995).

Crawford, J.A., & Fiorentino, R.V., *The Changing Landscape of Regional Trade Agreements*, WTO Discussion Paper No. 8 4:

<http://www.wto.org/english/res_e/reser_e/discussion_papers_e.htm>

Forgione, A., "Weaving the Continental Web: Exploring Free Trade, Taxation, and the Internet" (2003), 9-SUM L. & Sus. Rev. Am. 513.

Hill, C.W., *International Business: Competing in the Global Marketplace* (1997).

Hoffman, M., *Revised Guide to International Trade Law Sources on the Internet*, LLRX: <<http://www.llrx.com/features/trade3.htm>>

Lamy, P., *Regional Agreements: The 'pepper' in the multilateral 'curry'*, Speech 17 Jan 2007: <http://www.wto.org/english/news_e/sppl_e/sppl53_e.htm>
Petersmann, E-U., *Reforming the World Trading System: Legitimacy, Efficiency, and Democratic Governance* (2005).

6.1.2.2 Regional Institutions

Plan Puebla Panamá (PPP): <<http://www.planpuebla-panama.org/main-pages/concepto.htm>>
Initiative for Integration of South American Regional Infrastructure (CAF): <<http://www.caf.com/view/index.asp?ms=11&pageMs=14448>>
Alternativa Bolivariana para las Américas (ALBA): <<http://www.alternativabolivariana.org/>>
Andean Community of Nations: <<http://www.comunidadandina.org/endex.htm>>
Mercado Común del Sur (Mercosur): <<http://www.mercosur.int/msweb/>>
Caribbean Community (CARICOM): <http://www.caricom.org/>

6.1.2.3 DR-CAFTA and its Signatory States

Avalos, F. & Garmon, M., *Basic Info and Online Sources for NAFTA and CAFTA Research*, Globalex: <http://www.nyulawglobal.org/globalex/NAFTA_CAFTA_Research.htm>
Globalex also includes legal research guides for individual countries and has guides for every DR-CAFTA member except for El Salvador and the Dominican Republic.

The US Senate and the US House both produced reports reviewing the DR-CAFTA agreement. They are available via THOMAS: <<http://thomas.loc.gov/>>

The Tripartite Committee (IDB, OAS & ECLAC), *A Comparative Guide to the Chile-United States Free Trade Agreement and the Dominican Republic-Central America-United States Free Trade Agreement*: <http://2005.sice.oas.org/TPCStudies/USCAFTACHl_e/Contents.htm>

6.1.2.4 Debate Surrounding the Formation of DR-CAFTA

Office of US Trade Representative, *The Case for CAFTA*: <http://www.ustr.gov/Trade_Agreements/Bilateral/CAFTA/Briefing_Book/Section_Index.html>; *Short Summary of the CAFTA*: <http://www.ustr.gov/Trade_Agreements/Bilateral/CAFTA/Briefing_Book/Section_Index.html>; *CAFTA will shrink the US Trade Deficit*: <http://www.ustr.gov/Trade_Agreements/Bilateral/CAFTA/Briefing_Book/Section_Index.html>

Avalós, A., "País defiende acceso a medicinas genéricas" (October 10, 2003), *La Nación*, p.6.
Barrionuevo, A. & Becker, E., "Fewer Friends in High Places for This Lobby" (June 2, 2005), *New York Times*: <<http://www.nytimes.com/2005/06/02/business/02sugar.html?pagewanted=print>>
Comisión de Asuntos Jurídicos, *Ventajas y desventajas del CAFTA en el sector salud* (2005), Briefing paper, Asamblea Legislativa de Costa Rica:

<http://www.asamblea.go.cr/servicios_tecnicos/w_dst/contenido/documentos/documentos%20dst%20oficios%5Cct%5CCTI2005%5CCON-I-025-2005.pdf>

Cook, L., “La Negociación del DR-CAFTA: maquinando y presionando”, in: *Observatorio: El TLC entre los EEUU, Centroamérica y la República Dominicana en su primer año*, (2007): <http://www.cispes.org/cafta/observatorio_cafta.pdf>

Solís, O., “¿No ha estudiado el TLC?” (April 5, 2007), *La Nación*: <<http://www.pac.or.cr/sitio1/paginas/noticias.php?id=785&seccid=1®istrar=1>>

6.1.3 US Trade Act 1974, s. 301

International Intellectual Property Alliance: <<http://www.iipa.com/>>; specifically, *2007 Special 301 Report* (2007) p.25:

<<http://www.iipa.com/rbc/2007/2007SPEC301COSTARICA.pdf>>

Grier, J.H., *Section 301 of the 1974 Trade Act* (2005), US Dept. of Commerce.

Available at: <<http://www.osec.doc.gov/ogc/occic/301.html>>

Monten, L.M., “The Inconsistency between Section 301 and TRIPS:

Counterproductive with Respect to the Future of International Protection of Intellectual Property Rights?” (2005), 9 *Marq. Intell. Prop. L. Rev.* 387.

Pechman, R.J., “Seeking Multilateral Protection for Intellectual Property: The United States “TRIPS” over Special 301” (1998), 7:1 *Minnesota Journal of Global Trade* 179.

6.1.4 Trade Promotion Authority (TPA)

As the extension of the TPA is a current political issue, a wide variety of news sources may be useful. In addition, general web searches can reveal a significant quantity of material regarding the original 2002 legislative bill. The following articles and websites provide a useful starting place for the issue:

US Trade Promotion Authority Act (2002):

<http://www.bilaterals.org/IMG/pdf/TPAA_2002.pdf>

US Chamber of Commerce, *Trade Promotion Authority*:

<http://www.uschamber.com/issues/index/international/tpa.htm>

US Department of State, *Trade Promotion Authority*:

<http://www.state.gov/g/oes/rls/fs/2002/12953.htm>

Slevin, C. & Tucker, T., “The Fair Trade Sweep”, *The Democratic Strategist*:

<<http://www.thedemocraticstrategist.org/0701/slevintucker.php>>

Wright, L., “Note: Trade Promotion Authority: Fast Track for the Twenty-First Century?” (2004), 12 *Wm. & Mary Bill Rts. J.* 979.

6.1.5 FTAA

The Free Trade Areas of the Americas Official Website: <<http://www.ftaa-alca.org/>>

Bruner, C.M., “Hemispheric integration and the politics of regionalism: the free trade area of the Americas (FTAA)” (2002), 33 *U. Miami Inter-Am. L. Rev.* 1

Rivas-Campo, J.A. & Benke, R.T.J., “FTAA Negotiations: short overview” (2003), 6 *J. Int’l Econ. L.* 661

Vivas-Egui, D., *Regional and bilateral agreements and a TRIPS-plus world: the Free Trade Area of the Americas (FTAA)*, TRIPS Issues Papers 1, Quaker United Nations Office (2003) 12-13.

Vuegas, M.S., "The Development of the free trade area of the Americas: a guide for legal research" (2005) 33 *Int'l J. Legal Info.* 11

6.1.6 ALBA

Alternativa Bolivariana para las Américas (ALBA):

<<http://www.alternativabolivariana.org/>>

Agreement between the President of the Bolivarian Republic of Venezuela and the President of the Council of State of Cuba, for the Application of the Bolivarian Alternative for the Americas (December 14, 2004):

<<http://www.mltoday.com/Pages/NLiberation/Cuba-VenezPact.html>>

TeleSUR's mission statement:

<<http://www.telesurtv.net/secciones/concepto/index.php>>

Fawthrop, T., "Havana's Operation Miracle helps eye patients see the light" (2005), *Scotsman*: <<http://news.scotsman.com/health.cfm?id=2305142005>>

Harris, D. & Azzi, D., *ALBA "Venezuela's answer to "free trade": the Bolivarian Alternative for the Americas*" (2006), *Focus on the Global South*:

<<http://www.focusweb.org/alba-venezuela-s-answer-tofree-trade-the-bolivarian-alternative-for-the-ame.html>>

6.2 E-Commerce issues

6.2.1 General

School of Information Resources & Library Science, University of Arizona, *The Information Professional's Glossary*:

<<http://www.sir.arizona.edu/resources/glossary.html>>

US Trade Promotion Authority Act 2002:

http://www.bilaterals.org/IMG/pdf/TPAA_2002.pdf

LANIC – Internet & Computing in Latin America

<<http://lanic.utexas.edu/subject/internet/>>

University of Edinburgh Research projects, *Implementing European E-Commerce Legislation*: <<http://www.law.ed.ac.uk/ahrc/projects/view.aspx?id=8>>

Internet Governance Forum: <<http://www.intgovforum.org/>>

Edwards, L (ed), *The New Legal Framework for E-Commerce in Europe* (2005).

Edwards, L., & Waelde, C., *Law and the Internet II: A Framework for Electronic Commerce* (2000).

Graham, C. & Smith, F., *Competition, Regulation and the New Economy* (2004).

Mitchell, A.D., "Towards Compatibility: The Future of Electronic Commerce Within the Global Trading System" (2002), 4 *JIEL* 683.

Kossick, R.M., "The Emerging Disharmony of Electronic Commerce Legislation in Latin America" (2001) 9 *Tul. J. Int'l & Comp. L.* 387.

Nagle, L.E., "E-Commerce in Latin America: Legal and Business Challenges for Developing Enterprise" (2001) 50 *Am. U. L. Rev.* 859.

Willingham, J.B., "Electronic Commerce and the Free Trade Area of the Americas" (2000) 6 *NAFTA: L. & Bus. Rev. Am.* 483.
Wunsch-Vincent, S., "The WTO, the Internet and Trade in Digital Products" (2006).

6.2.2 Trade Law

WTO, *Ministerial Declaration on Global Electronic Commerce* (25th May 1998), WT/MIN(98)/DEC/2:
<http://www.wto.org/english/tratop_e/ecom_e/mindec1_e.htm>
For the latest reports on the status of electronic commerce in the WTO see WTO website: <http://www.wto.org/english/tratop_e/ecom_e/ecom_e.htm>; documents WT/GC/W/555 (<<http://docsonline.wto.org/DDFDocuments/t/WT/GC/W555.doc>>) and WT/GC/W/556 (<<http://docsonline.wto.org/DDFDocuments/t/WT/GC/W556.doc>>).

Mitchell, A.D. "Towards Compatibility: The Future of Electronic Commerce within the Global Trading System" (2001), *J. Int'l Econ. L.* 683-723.
Willingham, J.B. "Electronic Commerce and the Free Trade Area of the Americas" (2000) 6 *NAFTA: L. & Bus. Rev. Am.* 483.
Wunsch-Vincent, S., *The WTO, The Internet and Trade in Digital Products* (2006).

6.2.3 E-Commerce in Latin America

Kossick, R.M., "The Emerging Disharmony of Electronic Commerce Legislation in Latin America" (2001), 9 *Tul.J. Int'l & Comp. L.* 387
Nagle, L.E., "E-Commerce in Latin America: Legal and Business Challenges for Developing Enterprise" (2001), *Am. U. L. Rev.* 859.

6.3 Intermediary liability

As the intermediary liability provisions of DR-CAFTA are based on US law, there exists a wide variety of material analysing the US provisions. These should be consulted when doing comparative work on specific provisions. What follows below is a selection of materials with a focus on the international scene.

Digital Millennium Copyright Act of 1998, Summary available at:
<<http://www.copyright.gov/legislation/dmca.pdf>>

Edwards L., & Waelde C., *Online Intermediaries and Liability for Copyright Infringement, prepared for World Intellectual Property Organization seminar on Copyright and Internet Intermediaries* (2005), available at:
http://www.wipo.int/meetings/en/2005/wipo_iis/program.html
Hinze, G., *EFF Briefing Paper: Internet Service Provider Safe Harbors and Expedited Subpoena Process in the U.S. Digital Millennium Copyright Act and Recent Bilateral Free Trade Agreements*:
<http://www.eff.org/IP/FTAA/ISP_june05.pdf>

6.4 Intellectual Property

6.4.1 International Aspects of Intellectual Property Law

World Intellectual Property Organisation, Treaties Database:

<http://wipo.int/treaties/en/Remarks.jsp?cnty_id=1936C>

Abbott, F.M., *The Doha Declaration on the TRIPS Agreement and Public Health and the Contradictory Trend in Bilateral and Regional Free Trade Agreements* (2004), Occasional Paper 14, Quaker United Nations Office, available at: www.uno.org.

Cornish, W.R., "The International Relations of Intellectual Property" (1993), 52 *Cam L.J.* 46

Dinwoodie, G.B., "Ten Years of Trademark Law: Lessons for the Future?" in:

Hansen, H. (ed), *International Intellectual Property Law and Policy* (2003):

<<http://www.kentlaw.edu/depts/ipp/publications/tenyearsoftmlaw.pdf>>.

Dinwoodie, G.B., "The Architecture of the International Intellectual Property System" (2002), 77 *Chi.-Kent L. Rev.* 993.

Drahos, P., *Bilateralism in Intellectual Property*:

http://www.oxfam.org.uk/what_we_do/issues/trade/bilateralism_ip.htm

Drahos, P., "Bits and Bips. Bilateralism in Intellectual Property" (2001), 4(6) *The Journal of World Intellectual Property* 791.

Helfer, L.R., "Regime Shifting: The TRIPS Agreement and New Dynamics of International Intellectual Property Lawmaking" (2004), 29(1) *Yale Journal of International Law* 84.

Perlmutter, S., "Future Directions in International Copyright" (1998), 16 *Cardozo Arts & Ent. L.J.* 369.

Yu, P.K., "Currents and crosscurrents in the International Intellectual Property Regime" (2004), 38 *Loyola of Los Angeles Law Review* 210.

6.4.2 Digital Rights Management

Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society:

<http://www.ebu.ch/departments/legal/pdf/leg_ref_ec_directive_copyright_infosociet y_220501.pdf>

Ley de Procedimientos de Observancia de los Derechos de Propiedad Intelectual, número 8039 de 5 de octubre del 2000:

<http://www.castropal.com/resource/pdfs/ley_procedimiento.pdf>

Dusollier, S., "Electrifying the Fence: The Legal Protection of Technological Measures for Protecting Copyright" (1999), 21(6) *EIPR* 285.

6.4.3 Anti-Circumvention measures & FTAs

As with the intermediary liability section of DR-CAFTA, the treaty provisions are modelled on a US law, the DMCA. Comparative research on these provisions should consult primary US materials, which are plentiful and available. What follows are

selected articles dealing with the incorporation of DMCA anti-circumvention provisions in free trade agreements.

Chander, A., "Exporting DMCA Lockouts" (2006), 54 *Clev. St. L. Rev.* 205.

Garlick, M.K., "Locking up the Bridge on the Digital Divide – A Consideration of the Global Impact of the U.S. Anti-Circumvention Measures for the Participation of Developing Countries in the Digital Economy" (2004), 20 *Santa Clara Computer & High Tech. L.J.* 941.

Li-Dar Wang R., "DMCA Anti-Circumvention Provisions in a Different Light: Perspectives from Transnational Observation Of Five Jurisdictions" (2006), 34 *AIPLA Q.J.* 217.

Yu, P.K., "Anticircumvention and Anti-Anticircumvention" (2006), 84 *Denv. U. L. Rev.* 13 (2006).

6.4.4 Statutory Damages for Copyright infringement

Barker, J.C., "Grossly Excessive Penalties in the Battle Against Illegal File-Sharing: The Troubling Effects of Aggregating Minimum Statutory Damages for Copyright Infringement" (2004), 83 *Texas Law Review* 525.

Boag, J., "The Battle of Piracy versus Privacy: How the Recording Industry Association of America (RIAA) Is Using the Digital Millennium Copyright Act (DMCA) As Its Weapon Against Internet Users' Privacy Rights" (2004), 41 *California Western Law Review* 241.

6.5 UDRP, WHOIS & Internet Governance

6.5.1 UDRP

Uniform Domain Name Dispute Resolution Policy (UDRP):

<<http://www.icann.org/udrp/udrp-policy-24oct99.htm>>

WIPO, Guide to the UDRP: <<http://www.wipo.int/amc/en/domains/guide/index.html>>

Berkman Center for Internet and Society, *The UDRP Process*

<<http://cyber.law.harvard.edu/udrp/process.html>>

ICANN's UDRP page <<http://www.icann.org/udrp/udrp.htm>>

UDRP timeline <<http://www.icann.org/udrp/udrp-schedule.htm>>

Nominet (UK): <<http://www.nominet.org.uk/disputes/drs/policy/?contentId=3069>>

Example of ccTLD: .gb, which is no longer in use but is run by JANET.

<<http://www.iana.org/rootwhois/gb.htm>>

Regulaciones del NIC en Costa Rica, La Gaceta No.243 del 13 de diciembre del 2004.

An Update on Bias Allegations and the ICANN UDRP:

<<http://aix1.uottawa.ca/~geist/fairupdate.pdf>>

Societe Gervais Danone v Societe le Reseau Voltaire [2003] E.T.M.R 26.

Meat and Livestock Commission v Pearce [2004] E.T.M.R. 26

Vivendi v Sallen D2001-1121:

<<http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1121.html>>

Cyberbritain UK Ltd v Nominet UK Ltd (2005) (QBD) (unreported):

<<http://www.outlaw.com/page-5979>>

Bettinger, T., Willoughby, T., & Abel, S.M., *Domain Name Law and Practice: An international handbook* (2005).

Bettinger, T., *Uniform Domain Name Dispute Resolution Policy*: http://www.oup.com/uk/booksites/content/0199278253/part_3

Donahey, “The UDRP: Fundamentally Fair, But Far From Perfect” (2001), 6(34) *Electronic Commerce & Law Reports*: <<http://www.tzmm.com/frames/fartics.htm>>

Froomkin, A.M., “ICANN'S 'Uniform Dispute Resolution Policy' - Causes and (Partial) Cures” (2002) 67 *Brook. L. Rev.* 605.

Geist, M., *Fair.com?: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP*: <<http://aix1.uottawa.ca/~geist/geistudrp.pdf>>

Helfer, L.R. & Dinwoodie, G., “Designing Non-national systems: The case of the Uniform Domain Name Dispute Resolution Policy” (2001), 43 *Wm. & Mary L. Rev.* 141.

Helfer, L.R., “Whither the UDRP: Autonomous, Americanized, or Cosmopolitan?” (2004), 12 *Cardozo J. Int'l & Comp. L.* 493.

Hess, C., “TLC, ALCA e Internet” (March 10, 2004), *La Nación*: <http://www.nacion.com/ln_ee/2004/marzo/10/opinion2.html>

McMahon, R., “Certainty Still Some Way Off for Non-Commercial Use of Trade Marks in Domain Names” (2005), 10(5) *Comms. L.* 153

Pastukhov, O., “Internationalised Domain Names: the window of opportunity for cybersquatters” (2006), 4 *Intellectual Property Quarterly* 423.

Waelde, C., “Trade Marks and Domain Names: There's a lot in a name” in: Edwards, L. & Waelde, C. (eds), *Law and the Internet: Regulating Cyberspace* (2000).

Wilson, “Internationalised Domain Names: Problems and Opportunities” (2004), 10(7) *C.T.L.R.* 174.

Yu, P.K., “The Neverending ccTLD Story” in: Schlesinger, E. (ed), *Addressing the World: National Identity and Internet Country Code Domains*, (2003): Available at <SSRN: <http://ssrn.com/abstract=388980>>

Yu, P.K., “The Origins of ccTLD Policymaking” (2004), 12 *Cardozo J. Int'l & Comp. L.* 387.

Zittrain, J., “ICANN: Between the public and the private (Comments before Congress)” (1999), 14 *Berkeley Tech. L.J.* 107.

6.5.2 WHOIS

ICANN has recently put out a report on the privacy issues surrounding the WHOIS database. This report and accompanying materials should be consulted at first instance. In addition, there are several sources from civil society websites, selections from which follows.

ICANN Materials: <<http://gnso.icann.org/issues/whois-privacy/>>

ICANN Whosis task force: <<http://www.icann.org/announcements/announcement-16mar07.htm>>

IP Justice: <<http://ipjustice.org/campaigns/internet-governance/icann/whois/>>

Electronic Privacy Information Centre: <<http://www.epic.org/privacy/whois/>>

Circle ID: <<http://www.circleid.com/>>; specifically:

<http://www.circleid.com/posts/wall_street_journal_whois_privacy/>

Privacy International <<http://www.privacyinternational.org/>>

6.5.3 UDRP & Internet Governance

Working group on Internet Governance: <<http://www.wgig.org/>>
WSIS outcome documents: <<http://www.itu.int/wsis/documents/index2.html>>;
<<http://www.itu.int/wsis/docs2/tunis/off/6rev1.html>>; See also
<http://www.theregister.co.uk/2005/12/02/rice_eu_letter/>
Internet Governance forum: <<http://www.intgovforum.org/>>
IP-watch: <<http://www.ip-watch.org/weblog/index.php?p=447&res=1024&print=0>>;
<<http://igf2006.info/workshops/legal-aspects>>

6.6 Competition Law

WTO webpage, *Interaction between Trade and Competition Policy*:
<http://www.wto.org/english/tratop_e/comp_e/comp_e.htm>
WTO, *Doha Ministerial Declaration*, WT/MIN(01)/DEC/1, paras 23-5:
<http://www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_e.htm#interaction>
WTO, *Decision of General Council, 1 August 2004*, WT/L/579
<http://www.wto.org/english/tratop_e/dda_e/draft_text_gc_dg_31july04_e.htm>

International Competition Network:
<<http://www.internationalcompetitionnetwork.org/index.php/en/about-icn>>
International Committee for Information Technology Standards:
<<http://www.incits.org/>>
Dynamic Coalition on Open Standards:
<http://www.cptech.org/a2k/igf/athens110206/key_docs.htm>

Commission Decision of 24/03/04 relating to a proceeding under Article 82 of the EC Treaty (Case COMP/C-3/37.729 Microsoft), available via:
<<http://ec.europa.eu/comm/competition/antitrust/cases/decisions/37792/en.pdf>> and
US v. Microsoft Corp: <http://www.usdoj.gov/atr/cases/ms_index.htm>

Lemley, M.A. & McGowan May, D., “Legal Implications of Network Economic Effects” (1998), 86 *Calif. L. Rev.* 479
Lemley, M.A., “Standardizing Government Standard-Setting Policy for Electronic Commerce” (1999), 14 *Berkeley Tech. L.J.* 745
Marsden, M., *A Competition Policy for the WTO* (2003).

6.7.1 Central American Competition Laws

ECLAC, *Strengthening Competition in the Central American Isthmus*:
<<http://www.eclac.cl/mexico/competencia/proyecto/indexing.htm#>>

6.7 Telecoms

6.7.1 General

Pipe, G.R., “Free Trade Agreements Feature E-Commerce and Telecom Trade” (2003), 26 *I-Ways, Digest of Electronic Commerce Policy and Regulation* 44.

Wei & Kolko, B.E., "Studying mobile phone use in context: cultural, political, and economic dimensions of mobile phone use", in: *Proceedings of the Professional Communication Conference* (2005), pp.205- 212.

6.7.2 Digital Divide

Akyildiz, I.F. & Wang, X., "A survey on wireless mesh networks" (2005), 43(9) *Communications Magazine* 23.

Fink, C., & Kenny, C.J., "W(h)ither the digital divide?" (2003) 5(6) *Info* 15.

Guadamuz, A., "The Digital Divide: It's the Content, Stupid!" (2005) *Computer and Telecommunications Law Review*, 73-77 & 113-118.

6.8 Cultural aspects of FTAs

Galt, F.S., "The life, death and rebirth of the "cultural exception" in the multilateral trading system: an evolutionary analysis of cultural protection and intervention in the face of American pop culture's hegemony" (2004), 3 *Wash. U. Global Stud. L. Rev.* 909

Moran, B.I., "United States' Trade Policy and the Exportation of United States' Culture" (2004), 7 *Vand. J. Ent. L. & Prac.* 41

Note: the following annexes contain work conducted subsequent to the original Scoping Report, which is currently available on the SSRN.

Annex A: Information Technology Agreement & Free Trade Agreements

1.0 Introduction

The Ministerial Declaration on Trade in Information Technology Products¹ calls for participants to eliminate duties on IT products specified within Attachments A and B of the Declaration². The Declaration was the precursor to the WTO Information Technology Agreement (ITA) (1997), which currently has 70 participants, approximating 97 per cent of world trade in information technology products³. WTO Director-General Pascal Lamy noted at the WTO Information Technology Symposium on 28th March 2007 (celebrating the 10th anniversary of the ITA) that the ITA represents “a major success”⁴. He reported:

“World exports of ITA products over the past 10 years have more than doubled in dollar terms, reaching US\$ 1450 billion in 2005 with annual average growth of 8.5 per cent. In 2005, trade on ITA products accounted for 14 per cent of the world merchandise exports, exceeding that of agricultural products, and textiles and clothing together. I believe that it is therefore fair to say that the ITA has been a major success since the establishment of the WTO.”⁵

1.1 ITA Membership & Committee

At the formation of the Declaration, 29 states or separate customs territories (including the 15 EC Member States) signed the Declaration⁶, accounting for 83% of the world trade in IT products. In accordance with the provisions of the Declaration, the ITA could not take effect until the participants accounted for 90% of the world trade in IT product. This target was rapidly achieved, as in the ensuing few months a wave of accessions took place⁷.

¹ WTO, Ministerial Declaration on Trade in Information Technology Products (Dec 13, 1996): http://www.wto.org/english/docs_e/legal_e/itadec_e.pdf

² Note: developing country participants have been granted extended periods of implementation for some products.

³ WTO, *Information Technology Agreement*:

http://www.wto.org/english/tratop_e/inftec_e/inftec_e.htm; see also, Reports on the Status of Implementation by the Committee of Participants on the Expansion of Trade in Information Technology Products (ITA Committee): available from http://www.wto.org/english/tratop_e/inftec_e/inftec_e.htm

⁴ WTO News, *Lamy says ITA success is inspiration to Doha negotiators* (March 28, 2007): http://www.wto.org/english/news_e/sppl_e/sppl58_e.htm

⁵ *Ibid.*

⁶ These were: Australia, Canada, Chinese Taipei, European Communities, Hong Kong, Iceland, Indonesia, Japan, Korea, Norway, Singapore, Switzerland (including Liechtenstein), Turkey, and the United States. See WTO, *Information Technology Agreement - Introduction*: http://www.wto.org/english/tratop_e/inftec_e/itaintro_e.htm

⁷ The Czech Republic, Costa Rica, Estonia, India, Israel, Macau China, Malaysia, New Zealand, Romania, Slovak Republic, and Thailand. In addition, El Salvador, Panama, the Philippines, and

The participants established the Committee of Participants on the Expansion of Trade in Information Technology Products (“ITA Committee”) in 1997⁸. The ITA Committee holds about five formal meeting per year.

1.2 Product Coverage

The product coverage of the ITA remains a controversial issue (discussed below). At present, the products covered by the ITA are listed in Attachments A and B of the Declaration. These include computers, monitors, telecommunications equipment (including telephones, fax machines, switching apparatus, transmission apparatus (not TV or radio), portable receivers and optical fibre cables), semiconductors, semiconductor manufacturing equipment, software, and scientific instruments (e.g. electronic instruments used to measure the flow of gases or liquids).

2.0 Continuing Negotiations

2.1 Non-Tariff Measures & Classification Divergences

Although the ITA is solely a tariff cutting measure, in 2000 the participants approved a Work Programme on Non-Tariff Measures⁹. Work under this program continues today.¹⁰ In April 2003 the ITA Committee held a workshop to discuss electromagnetic compatibility/electromagnetic interference (EMC/EMI) measures. In preparation for the Workshop, Member States responded to a survey on EMC/EMI measures, the results of which were discussed at the Workshop¹¹. The Work Programme appears to have stalled and, as yet, the ITA Committee has not agreed on what should come next¹². It is also worth noting that the US delegate, among others, has noted that “a number of informal discussions on [non-tariff trade barriers] affecting the electronic industry had been held at the margins of [the non-agricultural market access (NAMA)] meetings”¹³.

The ITA committee has also dedicated a significant portion of its time to addressing IT products classification divergence among the Member States¹⁴.

Poland submitted schedules by 1 April 1997 but these were not approved until a significant time later. See WTO, *Information Technology Agreement – Introduction*, *supra*. 6; see also WTO News, *Ruggiero cites progress in Information Technology Agreement* (1997), Press/69:

<http://www.wto.org/english/news_e/pres97_e/pr69_e.htm>

⁸ WTO Council for Trade in Goods, *Implementation of the ministerial declaration on trade in information technology products* (Apr 2, 1997), WT G/L/160: available from:

<http://www.wto.org/english/docs_e/docs_e.htm>

⁹ WTO News, *ITA Committee approves work programme on non-tariff measures* (Nov 17, 2000):

<http://www.wto.org/english/news_e/pres00_e/pr198_e.htm>

¹⁰ See *Report (2006) of the Committee of Participants on the Expansion of Trade in Information Technology Products* (Nov 7, 2006), G/L/797: available from

<http://www.wto.org/english/tratop_e/inftec_e/inftec_e.htm>

¹¹ For papers presented at the Workshop see *WTO EMC/EMI Workshop* (April 23-24, 2003):

<http://www.wto.org/english/news_e/events_e/programme_emc_emi_april03_e.htm>

¹² See WTO ITA Committee, *Minutes of the Meeting of 31st October 2006*, G/IT/M/47, para 3: available from <http://www.wto.org/english/tratop_e/inftec_e/inftec_e.htm>

¹³ *Ibid.*

¹⁴ See Reports of the ITA Committee: available from

<http://www.wto.org/english/tratop_e/inftec_e/inftec_e.htm>

2.2 Product Coverage

Since the inception of the ITA, the parties to the agreement have attempted to re-negotiate the ITA's product coverage¹⁵. The first review of the ITA's product coverage commenced in October 1997, and it continues today¹⁶. Most recently the US has submitted a communication to the ITA Committee which does not propose to expand the ITA's product coverage, but rather focuses how the current list of products can be maintain so as to ensure the "ITA can continue to provide real market access opportunities"¹⁷. As the US delegation explained:

"When product coverage for the ITA was finalized almost ten years ago, it reflected products that were available in the marketplace and on the forefront of technology at the time. Many of those same ITA products have now become more sophisticated, incorporating new technologies or additional functions that also may be found in other information technology products. In fact, if we were to bring Attachments A and B to a modern electronics store or market today, we may be surprised at how many ITA covered products incorporate such new technologies or functions or are no longer considered to be at the forefront of technology."¹⁸

The products in issue are set-top boxes with a communication function, flat-panel displays, digital still image video cameras, and units of ADP machines¹⁹. One of the arguments made by the US is that while units of ADP machines (traditionally including devices such as printers and optical scanners), facsimile machines, and direct process and optical copiers are included under Attachment A of the Declaration, units of ADP machines now combine all of the above functions into one device²⁰. However, some Participants of the ITA no longer provide duty-free treatment to certain multifunctional units of ADP machines on the basis that such machines are not listed in the Declaration²¹. The US' proposal would simply update the Declaration's Attachments so as to reflect market conditions. Nevertheless, some states have challenged the US' proposals on the basis that it goes beyond updating products and actually constitutes the addition of products²². In the ITA Committee's October 2006 meeting, the US received support for its proposal from a number of states, including Japan, the EC, Canada, Hong Kong and the Philippines²³. The Committee agreed that there was "wide support for consultations to be held" and that

¹⁵ WTO, *Information Technology Agreement - Introduction*, *supra*. 6, para ITA II; see also, *Ibid.*

¹⁶ *Ibid.*; see also WTO News, *Participants agree to resume ITA II talks in February 1999* (1998): <http://www.wto.org/english/news_e/news98_e/ita2pr.htm>

¹⁷ *Coverage for Information Technology Products under the Information Technology Agreement (ITA): Communication from the United States* (Oct 23, 2006), G/IT/W/23, para 4: available from <http://www.wto.org/english/tratop_e/inftec_e/inftec_e.htm>

¹⁸ *Ibid.*, para 2.

¹⁹ *Coverage for Information Technology Products under the Information Technology Agreement (ITA): Communication from the United States* (Jan 12, 2007), G/IT/W/26, para 4: available from <http://www.wto.org/english/tratop_e/inftec_e/inftec_e.htm>

²⁰ *Ibid.*, para 6.

²¹ *Ibid.*

²² *Ibid.*, para 4.

²³ WTO ITA Committee, *Minutes of the Meeting of 31st October 2006*, G/IT/M/47, *supra*. 12, issue 6.

the Chairperson should hold informal consultations on how to proceed with the consultations regarding the US' proposal.

3.0 ITA & FTAs

The DR-CAFTA neither requires nor encourages signatory states to ratify the ITA. Nevertheless, all of the parties to the DR-CAFTA are participants of the ITA. However, not all parties to the DR-CAFTA were participants of the ITA prior to the formation of the DR-CAFTA. The USA, Costa Rica and El Salvador were early participants of the ITA, while Nicaragua, Honduras, the Dominican Republic and Guatemala have recently acceded to the Agreement.

The participants of the ITA, including the USA, have expressed their desire to increase global participation in the ITA. Thus the absence of reference to the ITA in the DR-CAFTA and, indeed, other FTAs is curious (see table 1). This may represent a gap in FTA negotiations which may have an impact on IT-based businesses.

Table 1: Participation by parties to US Regional/ Free Trade Agreements in the WTO Information Technology Agreement. None of the Regional/ Free Trade Agreements cited contains a reference to the ITA.

Free Trade or Regional Trade Agreement	Date Agreement was signed or entered into force	Parties to the agreement (Excluding the US)	Date from which state became a Participant of ITA*
US-Australia FTA	Signed May 18, 2004	Australia	December 1996 ⁺
US-Bahrain FTA	Signed September 14, 2004	Bahrain	Oct 2003
DR-CAFTA	Signed August 2, 2005	Guatemala	March 2007
		Honduras	Dec 2006
		Nicaragua	Dec 2006
		Costa Rica*	Nov 1997
		Dominican Republic	July 2006
		El Salvador*	Feb 1998
US-Chile FTA	After two years of negotiations entered into force Jan 1, 2004	Chile	Non-participant
US-Colombia Trade Promotion Agreement	Signed August 24, 2006	Colombia	Non-participant
US-Israel FTA	Entered into force September 1, 1985	Israel*	Nov 1997
US-Jordan FTA	Signed October 24, 2000	Jordan	March 2000
US-Korea FTA	Signed April 1, 2007	Korea	December 1996 ⁺
US-Morocco FTA	Signed June 15, 04	Morocco	Feb 2004
NAFTA FTA	Signed Jan 1, 1994	Canada	December 1996 ⁺

		Mexico	Non-participant
US-Oman FTA	Jan 19, 2006	Oman	April 2001
US-Panama Trade Promotion Agreement	Concluded negotiations December 19, 2006 (not currently in force)	Panama*	Although submitted schedules by April 1997, these could not be approved until April 2001
US-Peru Trade Promotion Agreement	Signed April 12, 2006	Peru	Non-participant
US-Singapore FTA	Implemented Jan 1, 2004	Singapore	December 1996 [†]
FTA/ RTAs currently in negotiations			
Southern African Customs Union Free Trade Agreement	Currently in Negotiations	Southern African Customs Union: Botswana, Lesotho, Namibia, South Africa and Swaziland	Non-participants
US- Malaysia FTA	Currently in Negotiations	Malaysia*	Nov 1997
US-Andean FTA	Currently in Negotiations	Andean States: Peru, Colombia, Ecuador	Non-participants
US-UAE FTA	Currently in Negotiations	UAE	Non-participant
Free Trade Area of the Americas	Currently in Negotiations	See: FTA Official Website, <i>Links to FTAA Countries:</i> < http://www.ftaa-alca.org/busfac/clist_e.asp >	8/34 of the proposed parties to the FTAA are participants of the ITA - all those that are party to the ITA are also party to one of the FTA's listed above.
US-Thailand FTA	Currently in Negotiations	Thailand*	Nov 1997

* These dates indicate the first date at which the Committee of Participants on the Expansion of Trade in Information Technology Products notes full participation of the designated nation in its Reports on the Status of Implementation. The reports are available from WTO, *Information Technology Agreement*: <http://www.wto.org/english/tratop_e/inftec_e/inftec_e.htm>, see para "ITA Schedules".

[†] Founding participant of the ITA.

* Expressed an interest in participating in the ITA within the few months following the Singapore Ministerial.

3.1 Further Work

At present little information is available regarding the influence of the ITA on free trade agreements and vice versa. Further work might be undertaken to compare the schedules contained within the FTAs with the product coverage of the ITA. The

FTAs may achieve the same result as the ITA, without making reference to it. In addition, one might investigate the reasons why Guatemala, Honduras, Nicaragua and the DR joined the ITA so soon after signing the DR-CAFTA, and why Colombia, Chile, Peru and Mexico have remained non-participants. In the same vein, it may be worth keeping an eye on the participation of parties currently negotiating RTAs in the ITA.

4.0 Additional Sources of Information

For an overview of the WTO system and its treaties, including the ITA, see WTO, *Understanding the WTO* (2007):

<http://www.wto.org/english/thewto_e/whatis_e/tif_e/understanding_e.pdf>;

Details of all the aforementioned free trade agreements may be found on the USTR website, *Bilateral Trade Agreements*:

<http://www.ustr.gov/Trade_Agreements/Bilateral/Section_Index.html>

For further information on the WTO non-agricultural market access negotiations see: WTO, *A simple guide – NAMA negotiations*:

<http://www.wto.org/english/tratop_e/markacc_e/nama_negotiations_e.htm>; also, minutes of the meetings of the Negotiating Group on Market Access are available from <http://www.wto.org/english/tratop_e/markacc_e/markacc_negoti_e.htm>

World Economic Forum, *Global Information Technology Report 2006-2007*:

<<http://www.weforum.org/en/initiatives/gcp/Global%20Information%20Technology%20Report/index.htm>>

Wunsch-Vincent, S. & McIntosh, J., *WTO, E-commerce, and Information Technologies: From the Uruguay Round through the Doha Development Agenda* (2005), Markle Foundation:

<<http://www.iie.com/publications/papers/wunsch1104.pdf>>

Annex B: DR-CAFTA & ICANN's Uniform Domain Name Dispute Resolution Policy

1.0 DR-CAFTA & Trade Marks

Article 15.2 of the DR-CAFTA sets minimum standards of protection for trade marks among the Signatory States.²⁴ For example, article 15.2(1) mandates that national laws protect as trade marks, collective, certification and sound marks. In contrast, Member States are given discretion as to whether they protect geographical indications and scent marks. Article 15.2 addresses a variety of trade mark issues, including limitations on the rights of trade mark holders (article 15.2(4)), the term of protection granted upon initial and renewal of registration (article 15.2(9)), formalities for trade mark licences (article 15.2(10)), the administration of trade mark registration (article 15.2(6)), and the protection of well known marks as outlined in the Paris Convention for the Protection of Industrial Property (1967) (article 15.2(5)). All parties to the DR-CAFTA were parties to the TRIPS Agreement prior to ratifying the DR-CAFTA and, therefore, had already agreed to minimum standards of protection for trade marks. However, the DR-CAFTA sets more onerous standards than those established by TRIPS. For example, the minimum term of protection upon registration required by TRIPS is seven years,²⁵ rather than the ten years required by the DR-CAFTA. Consequently, the DR-CAFTA has the potential to impact upon IT-based businesses. However, this annex will be confined to the specifically IT-related requirements of the DR-CAFTA regarding dispute resolution for domain name conflicts (article 15.4(1)).

1.1 Domain Name Dispute Resolution

The commercial value of memorable domain names has fuelled an abundance of disputes between trade mark holders and the registrants of domain names bearing resemblance to registered marks. Domain names were initially assigned on a first-come-first-served basis and, consequently, individuals freely registered domain names incorporating registered marks (or signs similar to registered marks), with the purpose of either benefiting from increased traffic to their site, or of profiting from the sale of the domain name to the trade mark holder. This practice became known as “cybersquatting”. In response to this phenomenon, some States implemented anti-cybersquatting legislation²⁶. In addition, global private dispute resolution mechanisms, such as the Uniform Domain Name Dispute Resolution Policy (UDRP)²⁷, were developed in order to provide trade mark holders with an expeditious alternative to national courts.

The UDRP is a policy operating between domain name registrars and registrants, which governs disputes between domain name registrants and trade mark holders. It was created by the Internet Corporation for Assigned Names and Numbers

²⁴ See DR-CAFTA, *supra*. 1, article 15.2.

²⁵ TRIPS, article 18.

²⁶ See for example the US Anti-cybersquatting Consumer Protection Act (1999) 15 U.S.C. § 1125

²⁷ See also the earlier Network Solutions, Inc's Dispute Resolution Policy; see Geist, M., *Fair.com?: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP*, p.9-12: <<http://aix1.uottawa.ca/~geist/geistudrp.pdf>>

(ICANN), and is based on proposals arising out of a US Department of Commerce White Paper²⁸ and a WIPO Report, *The Management of Internet Names and Addresses*.²⁹ The UDRP currently applies to all disputes concerning Top Level Domains (TLDs) controlled by ICANN; namely, the generic Top Level Domains (gTLDs), such as ‘.com’ and ‘.net’³⁰. ICANN requires all registrars who wish to receive the right to register domain names in the gTLD namespace to include in their registration agreements with domain name registrants, a clause requiring registrants to arbitrate relevant disputes using the UDRP³¹. The operators of other TLDs, such as the country-code TLDs (ccTLDs), are given discretion whether or not to follow the UDRP. ccTLDs are TLDs assigned to countries, such as ‘.cr’ for Costa Rica and ‘.uk’ for the United Kingdom. States control both the use of their ccTLD and which, if any, dispute resolution policy applies in connection with their ccTLD. The Country Code Names Supporting Organisation (ccNSO), an ICANN policy development body, was founded in 2003 for the purpose of:

“developing and recommending to the Board global policies relating to country-code top-level domains, nurturing consensus across the ccNSO's community, including the name-related activities of ccTLDs, and coordinating with other ICANN Supporting Organisations, committees, and constituencies under ICANN”.³²

Prior to the establishment of ccNSO, ICANN had spent many years pressuring governments to relinquish the ultimate control over their ccTLDs to ICANN. As McCarthy explained, “The concept that a US-based company, answerable to the US government, would be able to dictate exactly what every country in the world did with their Internet domains was ludicrous”³³. In the end, ICANN conceded its sovereignty and established the ccNSO to coordinate ccTLD related policy. Some states have elected to follow the UDRP, while others have subsequently designed their own dispute resolution policies.³⁴

In spite of the outcome of the earlier conflict over the global application of ICANN's policies, article 15.4 of the DR-CAFTA mandates that parties to the agreement provide in respect of their ccTLDs:

“an appropriate procedure for the settlement of disputes based on the principles established in the Uniform Domain-Name Dispute Resolution Policy”.

²⁸ Nat'l Telecomm. And Info. Admin., Department of Commerce, 63 Fed. Reg. 31, 741 (proposed June 10, 1998)

²⁹ The Management of Internet Names and Addresses: Intellectual Property Issues, WIPO: <<http://wipo2.wipo.int/process1/rfc/3/index.htm>>; see also ICANN, *Timeline for the formulation and implementation of the Uniform Domain-Name Dispute-Resolution Policy*: <<http://www.icann.org/udrp/udrp-schedule.htm>>

³⁰ Other gTLDs include .aero, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .tel and .travel.

³¹ ICANN, Uniform Domain Name Dispute Resolution Policy: <<http://www.icann.org/udrp/>>

³² ccNSO Website: <<http://ccnso.icann.org/>>

³³ McCarthy, K., “ICANN comes to terms with country domains” (June 27, 2003) *The Register*: <http://www.theregister.co.uk/2003/06/27/icann_comes_to_terms/>

³⁴ E.g. Nominet (UK): <<http://www.nominet.org.uk/disputes/drs/policy/?contentId=3069>>; See also ICANN, *Uniform Domain Name Dispute Resolution Policy* (Aug 26, 1999), Notes: <<http://www.icann.org/dndr/udrp/policy.htm>>

Notwithstanding the absence of official translations of the UDRP,³⁵ this 'UDRP-like' requirement is not unique to the DR-CAFTA. Similar provisions are present in, among others, the Chile-US FTA (article 17.3), the Singapore-US FTA (article 16.3) and the Australia-US FTA (article 17.3). In addition, the Third Draft Agreement of the FTAA includes a provision requiring parties to “participate in the ICANN Uniform Dispute Resolution Procedure”³⁶. These provisions may be seen as an indirect means of extending ICANN’s governance of the Internet.

2.0 The UDRP Dispute Resolution System

The UDRP³⁷ requires that domain name registrants submit to a “mandatory administrative proceeding” before one of the approved “administrative-dispute-resolution service providers” (DRP) if a third party asserts:

- “1. the registered domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
2. the domain name holder has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.”³⁸

It is for the complainant to prove that each of these three elements is present. Currently, there are three ICANN-accredited DRPs³⁹: the Asian Domain Name Dispute Resolution Centre (ADNDRC)⁴⁰, the National Arbitration Forum⁴¹ and the World Intellectual Property Organisation⁴² (WIPO). The Complainant may choose to submit the dispute for resolution to any of these approved DRPs.

Once proceedings are initiated, the Respondent has 20 days within which to submit a response to the Complainant’s submissions⁴³. The UDRP supplemental rules provided by the individual DRPs outline requirements of content and form which are essential for a valid response⁴⁴. In the majority of cases the dispute is

³⁵ Froomkin, A.M., *ICANN'S 'Uniform Dispute Resolution Policy' -- Causes and (Partial) Cures* (2002) 67 Brook. L. Rev. 605, p707. For further analysis of the potential implications of non-English domain names in this field, see Wilson, “Internationalised Domain Names: Problems and Opportunities” (2004), 10(7) *C.T.L.R.* 174, and Pastukhov, O., “Internationalised Domain Names: the window of opportunity for cybersquatters” (2006), 4 *Intellectual Property Quarterly* 423.

³⁶ *Free Trade Area of the Americas – third draft agreement* (Nov 21, 2003), article 13.1: available from <http://www.sice.oas.org/TPD/FTAA/FTAA_e.ASP#DraftTexts>

³⁷ ICANN, *Uniform Domain Name Dispute Resolution Policy* (Aug 26, 1999), para 4: <<http://www.icann.org/dndr/udrp/policy.htm>>

³⁸ ICANN, *Uniform Domain Name Dispute Resolution Policy* (Aug 26, 1999), para 4(a): <<http://www.icann.org/dndr/udrp/policy.htm>>

³⁹ ICANN, *Approved Providers for the Uniform Domain-Name Dispute-Resolution Policy*: <<http://www.icann.org/dndr/udrp/approved-providers.htm>>

⁴⁰ Asian Domain Name Dispute Resolution Centre (ADNDRC) website: <<http://www.adndrc.org/adndrc/index.html>>

⁴¹ National Arbitration Forum website: <<http://www.arb-forum.com/>>

⁴² WIPO Arbitration and Mediation Centre website: <<http://www.wipo.int/amc/en/index.html>>

⁴³ ICANN, *Rules for Uniform Domain Name Dispute Resolution Policy* (“the Rules”) (Oct 24, 1999), para 5: <<http://www.icann.org/dndr/udrp/uniform-rules.htm#6>>

⁴⁴ See for example the National Arbitration Forum, *The Forum’s UDRP Supplemental Rules* (Jan 1, 2006), para 5: <<http://domain.adrforum.com/users/icann/resources/UDRPSuppRules200601012.pdf>>

settled by a single panelist appointed by the DRP from their list of panelists. However, either party may request that the dispute is resolved by a three-member administrative panel (TAP). In such circumstances, both parties provide the DRP with a list of their preferred panelists. The UDRP Rules require that the DRP select one panelist from each of the lists, and selects a third panelist from a short-list of five panelists submitted by the DRP to the parties⁴⁵. While the fees for a single panelist resolution are paid for exclusively by the Complainant, the fees for a TAP resolution are shared equally in cases where the respondent requested the TAP. If the Complainant requests a TAP, but the Respondent fails to submit a response, the supplemental rules of the DRPs generally provide a means by which the Complainant may request a single-member administrative panel (SAP), rather than TAP⁴⁶.

SAPs and TAPs must forward their decision to the DRP within 14 days of being appointed⁴⁷. The decision should be based on the statements and documents provided by the parties, it must be in writing, and it must include reasons for the decision⁴⁸. In the case of a TAP decision, dissenting opinions must accompany the majority decision⁴⁹. The final decision is communicated to the parties within 3 days of the DRP's receipt of the decision⁵⁰. In addition, the Administrative Panel's (AP) decision will usually be published in full over the Internet. The remedies available to a complainant pursuant to the UDRP are limited to the cancellation of the disputed domain name, or the transfer of the domain name registration to the complainant.

There is no right of appeal from an AP decision, and the UDRP Rules expressly exclude liability of DRPs and panelists for erroneous decisions, other than in cases of deliberate wrongdoing⁵¹. However, the UDRP permits either party to submit the dispute for resolution by a national court. A party may do so before, during or after the mandatory administrative proceedings⁵². In such circumstances, the panel may suspend, terminate or continue with its proceedings⁵³. Where a party submits their dispute to a national court following the conclusion of mandatory administrative proceedings, the AP's decision will not be enforced providing the DRP

⁴⁵ ICANN, *Rules for Uniform Domain Name Dispute Resolution Policy* (Oct 24, 1999), para 6: <<http://www.icann.org/dndr/udrp/uniform-rules.htm>>

⁴⁶ See *The Asian Domain Name Dispute Resolution Centre Supplemental Rules to the Internet Corporation for Assigned Names and Numbers (ICANN) Uniform Domain Name Dispute Resolution Policy and the Rules for the Uniform Domain Name Dispute Resolution Policy* (Feb 28, 2002), para 8(2): <http://www.adndrc.org/adndrc/hk_supplemental_rules.html>; National Arbitration Forum, *The Forum's UDRP Supplemental Rules* (Jan 1, 2006), para 9(c)-(d): <<http://domain.adrforum.com/users/icann/resources/UDRPSuppRules200601012.pdf>>; cf WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (Dec 1, 1999): <<http://www.wipo.int/amc/en/domains/rules/supplemental/index.html#7>>

⁴⁷ ICANN, *Rules for Uniform Domain Name Dispute Resolution Policy* ("the Rules") (Oct 24, 1999), para 15(b): <<http://www.icann.org/dndr/udrp/uniform-rules.htm#6>>

⁴⁸ *Ibid.*, para 15(d).

⁴⁹ *Ibid.*, para 15(e).

⁵⁰ *Ibid.*, para 16(a).

⁵¹ *Ibid.*, para 20. Note the DRPs reiterate this point in their Supplemental Rules. For example, the ADNDRC's Supplemental Rules, *supra*. 19 (para 16), excludes liability except in cases of "fraud, dishonesty or deliberate wrongdoing".

⁵² See in combination ICANN, *Uniform Domain Name Dispute Resolution Policy* (1999), para 4(k): <<http://www.icann.org/udrp/>> and ICANN, *Rules for Uniform Domain Name Dispute Resolution Policy* (Oct 24, 1999), para 18: <<http://www.icann.org/dndr/udrp/uniform-rules.htm>>.

⁵³ ICANN, *Rules for Uniform Domain Name Dispute Resolution Policy* ("the Rules") (Oct 24, 1999), para 18: <<http://www.icann.org/dndr/udrp/uniform-rules.htm#6>>

receives evidence of the national court proceedings within 10 days of communicating the AP's decision. This provision envisions national courts continuing to address domain name disputes and, therefore, continuing to develop relevant jurisprudence.⁵⁴ It also provides a means by which parties dissatisfied with the AP's resolution can seek an alternative solution.

2.1 The UDRP Controversy

The UDRP is the subject of criticism by many commentators. Geist has noted that complainants and respondents are frustrated by "the number of inconsistent, wrongly-decided, and poorly reasoned UDRP decisions"⁵⁵. In addition, observers have suggested that the UDRP favours the rights of complainants (and, therefore, trade mark holders) over those of respondents (domain name registrants). In consequence, it has been suggested that in responding to the unscrupulous behaviour of cybersquatters, the UDRP has in turn enabled trade mark proprietors to inequitably depose legitimate domain name holders by accusing them of violating weak or defunct trade marks (a practice known as "reverse domain name hijacking")⁵⁶. This practice has also fuelled concerns that trade mark holders may use the UDRP as a means to prevent the use of domain names for critical comment⁵⁷. However, other commentators have argued that the UDRP fails to go far enough to protect trade mark holders, as it fails to provide damages as a remedy for cybersquatting⁵⁸.

2.1.1 Bias within the UDRP

In his influential critique of the UDRP system, Professor Mueller argued that the potential for "forum shopping" by complainants among the accredited DRPs leads to biased results and, indeed, encourages a greater number of domain name disputes⁵⁹.

⁵⁴ See Dinwoodie, G., "Ten Years of Trademark Law: Lessons for the Future?" in: Hansen, H. (ed), *International Intellectual Property Law and Policy* (2003), p.8: in particular the section 'Extending domestic law internationally'. Article can be found at:

<<http://www.kentlaw.edu/depts/ipp/publications/tenyearsoftmlaw.pdf>>. See also *Societe Gervais Danone v Societe le Reseau Voltaire* [2003] E.T.M.R 26.

⁵⁵ *Ibid.*, p.20.

⁵⁶ See e.g. Geist, M., *Fair.com?: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP.*: <<http://aix1.uottawa.ca/~geist/geistudrp.pdf>>; Donahey, "The UDRP: Fundamentally Fair, But Far From Perfect" (2001), 6(34) *Electronic Commerce & Law Reports*, available from <<http://www.tzmm.com/frames/fartics.htm>>; Donahey, *Fundamentally Fair.com? An Update on Bias Allegations and the ICANN UDRP.*: <<http://aix1.uottawa.ca/~geist/fairupdate.pdf>>; c.f. e.g. decision in *Meat and Livestock Commission v Pearce* [2004] E.T.M.R. 26

⁵⁷ See UDRP decision *Vivendi v Sallen* D2001-1121:

<<http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1121.html>>; and McMahon, R., "Certainty Still Some Way Off for Non-Commercial Use of Trade Marks in Domain Names" (2005), 10(5) *Comms. L.* 153.

⁵⁸ Searing, M.E. *What's in a Domain Name? A Critical Analysis of the National and International Impact on Domain Name Cybersquatting* (2000), 40 *Washburn LJ* 110.

⁵⁹ Mueller, M., *Rough Justice: An Analysis of ICANN's Uniform Dispute Resolution Policy*: <<http://dcc.syr.edu/miscarticles/roughjustice.pdf>>; see also Mueller, M., *Success by Default: A New Profile of Domain Name Trademark Disputes under ICANN's UDRP*(2002): <<http://dcc.syr.edu/markle/markle-report-final.pdf>>; for an opposing view see Branthover, N., *UDRP – A Success Story: A Rebuttal to the Analysis and Conclusions of Professor Milton Mueller in "Rough Justice"*(2002): <http://www.inta.org/downloads/tap_udrp_1paper2002.pdf>

Professor Geist⁶⁰ subsequently found that panelist selection by DRPs was biased towards panelists with a history of decisions favourable to complainants. In addition, he noted that the severity of this bias differed among the DRPs, and that complainant forum selection reflected the extent of a forum's bias towards complainants. However, this bias may not be as influential in forum selection as Geist suggested. Kesan and Gallo present evidence which they argue demonstrates that the duration of a DRP's dispute resolution procedure "is at least as important as bias in the selection of providers".⁶¹ Nevertheless, Kesan and Gallo conclude that complainants "choose a provider according to the importance they attach to the different factors which influence their decision", one of which is likely to be the severity of bias⁶². Indeed, when the former DRP, eResolution, publicly announced its departure from the UDRP arbitration business, it stated:

"The UDRP system gave complainants, who invoke intellectual property rights, the privilege to choose the provider. And statistics were soon released showing that complainants tended to win significantly more often with some providers, notably WIPO, than with others, notably eResolution, creating a perception of bias from which the system never recovered. [...] It is but an open secret that lawyers advising their clients in domain name cases have no scruples about quoting the figures and saying that the odds are better with a given provider."⁶³

Segal has recommended, as a means to remedy the alleged bias in the UDRP system, a "randomised" DRP selection process and an appeals procedure⁶⁴. Geist argues that all APs should involve three panelists, that minimum and maximum caseloads for panelists should be established and that the entire system must be more transparent⁶⁵. Kesan and Gallo suggest that the UDRP system may be made more homogenous by standardising the general procedures for handling and deciding claims⁶⁶.

3.0 UDRP & DR-CAFTA Signatory States

The DR-CAFTA requires that signatory states apply a dispute settlement procedure "based on the principles" established in the UDRP. The provision is unquestionably vague. At the minimum, the "principles" inherent in the UDRP must refer to the prohibition of the registration and use of domain names, which are identical or confusingly similar to trade marks, in bad faith. However, the creation of competition

⁶⁰ Geist, M., *Fair.com?: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP* (2001): <<http://aix1.uottawa.ca/~geist/geistudrp.pdf>>

⁶¹ Kesan, J.P. & Gallo, A.A., *The Market for Private Dispute Resolution Services – An Empirical Re-Assessment of ICANN-UDRP Performance* (2004), *bepress Legal Series*, paper 384, p. ii: <<http://law.bepress.com/cgi/viewcontent.cgi?article=1021&context=uiucwlps>>

⁶² *Ibid.*, pp.83-84

⁶³ Quoted from McCarthy, K., "eResolution quits domain arbitration" (Dec 4, 2001), *The Register*: <http://www.theregister.co.uk/2001/12/04/eresolution_quits_domain_arbitration/>; see also Bonisteel, S., *Arbitration Firm Quits Domain-Dispute Business – EResolution* (Dec 3, 2001), Newsbytes News Network: <http://findarticles.com/p/articles/mi_m0NEW/is_2001_Dec_3/ai_80510820>

⁶⁴ Segal, P., *Attempts to Solve the UDRP's Trademark Holder Bias: A problem that remains unsolved despite the introduction of new Top Level Domain Names*, 3(1) *Cardozo Journal of Conflict Resolution*: <<http://www.cojcr.org/vol3no1/notes02.html>>

⁶⁵ *Ibid.*, pp.26-32.

⁶⁶ Kesan & Gallo, *supra* 33. p.84.

between DRPs could also be seen as a fundamental principle of the UDRP – one which is highly controversial. Hess has expressed his concern at the inclusion of the “UDRP-like” provision in the DR-CAFTA on the basis that the system appears to be biased towards the protection of commercial interests.⁶⁷ Indeed, the UDRP only permits trade mark holders to challenge domain name registrants and, therefore, provides no remedy in cases of disputes based on the public interest. However, the equivocacy of article 15.4 of the DR-CAFTA appears to leave states with sufficient discretion to implement a UDRP-type policy that includes measures to counteract the current system’s bias.

5.0 Further work

Further work could be undertaken to determine:

- what, if any, domain name dispute resolution policies apply in the DR-CAFTA states? Is there much litigation? What is the nature of such litigation, if there is any? How have “UDRP-like” provisions been applied by states engaged in similar FTAs with the US?
- What alternatives to the UDRP system have been adopted by ccTLD registrars? Are these systems substantially different to the UDRP system? Do they display less bias?

In addition, it might be useful to explore the “principles” of the UDRP in order make recommendations on how article 15.4 ought to be implemented.

6.0 Additional Sources of Information

Engel, A., “International Domain Name Disputes: Rules and Practice of the UDRP” (2003) 25(8) E.I.P.R. 351

Pastukhov, O., “Internationalised Domain Names: the Window of Opportunity for Cybersquatters” (2006) 4 I.P.Q. 421

⁶⁷ Hess, C., “TLC, ALCA e Internet” (March 10, 2004), *La Nación*, p.15:
<http://www.nacion.com/ln_ee/2004/marzo/10/opinion2.html>